



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/980,845 | 04/08/2002 | Ann Progulske-Fox | 00-505-B | 3701 |
| 20306 7590 04/18/2008 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606 | | | | |
| EXAMINER | | | | |
| SHIBUYA, MARK LANCE | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1639 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 04/18/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/980,845

Applicant(s)

PROGULSKE-FOX ET AL.

Examiner

Mark L. Shibuya, Ph.D.

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: 222402-0302-022403-10305

DETAILED ACTION

1. Claims 1-17 are pending and examined.

Election/Restrictions

2. Applicant's election with traverse of an animal in the reply filed on 7/18/2007 is acknowledged. The traversal is on the ground(s) that both an animal and a microbe are components of the claimed methods. This is found persuasive. Therefore, the requirement for election of species, as set forth in the Requirement for Restriction/Election, mailed 6/19/2007, is withdrawn.

Priority

3. The instant application, Serial No. 09/980,845, filed 4/8/2002, states that it is the national stage of PCT/US00/21340, international filing date 8/4/2000; which claims benefit of U.S. Provisional Application 60/147,551, filed 8/6/1999.

Information Disclosure Statement

4. The information disclosure statements (IDS) submitted on 2/28/02; 6/3/02; 9/22/03; 10/3/05 were considered by the examiner.

Specification

5. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112, Second Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "an antigen". There is uncertain antecedent basis for this limitation in the claim. The relationship of the antigen in claim 2 to the "antigens" in claim 1, line 3, is unclear.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 7,033,748 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other.

The instant claims are drawn to a method of identifying a polynucleotide of a microbe that is expressed in vivo comprising the steps of: (a) adsorbing antibodies against antigens that are expressed by the microbe in vivo and in vitro with cells or cellular extracts of the microbe that have been grown in vitro; (b) isolating unadsorbed antibodies; and (c) probing an expression library of the microbe's DNA or RNA with the antibodies of step (b); wherein a polynucleotide of the microbe that is expressed in vivo is isolated and identified; and variations thereof.

Claims 1-11 of the '748 Patent are drawn to a method of identifying a polynucleotide of a microbe that is expressed in vivo comprising the steps of: adsorbing an antibody sample with cells or cellular extracts of the microbe that have been grown in vitro, wherein the antibody sample comprises antibodies specific for antigens expressed by the microbe when grown in vivo and antibodies specific for antigens expressed by the microbe when grown in vitro; isolating unadsorbed antibodies; and probing a phage display library of the microbe's DNA with the unadsorbed antibodies of step (b); wherein the step of probing a phage display library comprises: (i) immobilizing the unadsorbed antibodies on a solid support; (ii) adding the

Art Unit: 1639

phage display library of the microbe's DNA or RNA to the solid support; (iii) washing unbound phage from the solid support; and (iv) recovering phage that are bound to the solid support; wherein a polynucleotide of the microbe that is expressed in vivo is isolated and identified.

Thus the claims of the '748 Patent anticipates or makes obvious the claims of the instant application, as the species anticipates or makes obvious the genus.

Conclusion

10. Claims 1-17 are rejected.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shibuya, Ph.D. whose telephone number is (571) 272-0806. The examiner can normally be reached on M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. James Douglas Schultz can be reached on (571) 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark L. Shibuya, Ph.D.
Primary Examiner
Art Unit 1639

/Mark L. Shibuya, Ph.D./
Primary Examiner, Art Unit 1639